

REMARKS**Paragraphs 1 and 2 of the Office Action**

The disclosure is objected to and claim 1 and 7 are objected to because of informalities.

10 The disclosure has been amended as required. Applicant requests the withdrawal of the objections.

Paragraph 3 of the Office Action

15 Claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Del Mas in view of Lui.

 Claims 1-6 have been cancelled.

 The device of applicant's claims includes both body and head springs to form a bobble head doll wherein the body and the head both move. It is respectfully submitted that the Examiner has used hindsight to find these elements, as there is no motivation
20 within these elements to combine them. Lui shows a bobble head doll having a photo receiving chamber therein. The intention of Lui is to use conventional bobble head construction so that a user of the Lui doll may make a personalized doll by positioning a photo in the photo-receiving chamber. Alternate embodiments are not suggested within Lui as its construction fully contemplates its usage absent any deviation from standard
25 bobble head construction. For this reason, it is pure conjecture that Lui could be modified with knowledge supplied by Del Mas. Modification is not enough absent some showing that the modification is contemplated.

 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the
30 combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner
35 suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

5 In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

Here the Examiner states that “it would have been obvious to one having ordinary skill in the art at the time the invention was made *to modify* the doll of Del Mas....” If
10 such a modification were obvious, Lui would have altered the bobble head doll to include a body portion that would bobble as well. That Lui knew of Del Mas is obvious in light of the citation of Del Mas in the Lui patent. Additionally, Del Mas issued in 1956. Since then, untold millions of bobble head dolls have been sold, and yet the combination as shown within applicant’s device is not found.

15 Finally, Del Mas actually teaches away from a conventional bobble head movement. At column 3, line 44, Del Mas states that its construction “maintains a downward force on the head substantially along the center line thereof.” Del Mas does not want the head to bobble but be able only to move in a life-like manner. Column 3, lines 39-40. Because Del Mas teaches away from bobble head dolls, a finding of obvious
20 of modifying Del Mas in light of a bobble head cannot be found. The applicant readily accepts that applicant’s modification over traditional bobble heads is not severe. However, the variation is an improvement that has not been anticipated by the prior art and which has not been appreciated by bobble head doll manufacturers. The applicant’s device provides a doll which bobbles at the waist and at the head. While a minor
25 improvement, it is a non-obvious improvement nonetheless.

Progress in the crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage.

In re Meng and Driessen, 181 USPQ 94 (CCPA 1974).

30 Alternatively, it is respectfully submitted that the element of the upper ends of the legs being positioned within the torso is not shown in the prior art. Del Mas teaches an upper body and a lower body spaced from each other. This permits the body of the Del Mas doll to bend at the juncture of the upper and lower bodies. This exposes the spring, which can pose a potential danger to a child and which will reduce the life of the spring
35 as the excessive movement of the upper body will stretch out the string. By extending the neck into the head and the legs into the torso, the springs are hidden and limit the

5 amount of movement of the torso and head of applicant's device. This is an advantage not shown or taught by Del Mas.

For these reasons, the applicant respectfully requests withdrawal of the rejection.

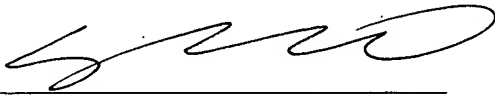
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CONCLUSION

10 In light of the foregoing amendments and remarks, early consideration and
allowance of this application are most courteously solicited.

Respectfully submitted,

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